

REMARKS

Applicant has considered and studied the Office Action dated January 31, 2006. Claims 1-22 are pending. Claims 1, 10 and 19 are independent claims. Claims 1-22 are rejected. It is respectfully submitted that the application is in condition for allowance.

§ 103 Rejections

Claims 1-22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Montalbano (U.S. Pat. No. 5,838,775) in view of Takase et al. ("Takase" U.S. Pat. No. 5,612,959) and further in view of Schuster et al. ("Schuster" U.S. Pat. No. 6,937,699). Applicant respectfully disagrees with the Examiner's interpretation of Montalbano and respectfully traverses the rejection.

It is respectfully noted that the Federal Circuit has provided that an Examiner must establish a case of prima facie obviousness. Otherwise the rejection is incorrect and must be overturned. As the court stated in In re Rijkaert, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993):

"In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. 'A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art.' If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned." (citations omitted.)

It is respectfully noted that the Examiner asserts, at paragraph 5 on page 3 of the Office action, that Takase discloses "performing a status check on terminals" at "col. 7, line 57 - col. 8, line 12" and that "[o]ne of ordinary skill in the art ... would have found it obvious to perform a status check on terminals ... [and] to combine this step with the communications network disclosed by Montalbano." Furthermore, the Examiner asserts, at paragraph 18 on page 7 of the Office Action, that Montalbano discloses the recited information server in "figure 1 [by illustrating] the use of a plurality of different databases to provide information to networked client devices and these databases are deemed analogous to the applicant['s] 'information

server” with the Examiner interpreting “information server” as “any type of device on a network that provides information to other devices on the network.”

Applicant respectfully disagrees with the Examiner’s interpretation of “information server” and respectfully submits that the information server recited in the claims of the present invention is required do much more than simply “provide information to other devices on the network.” Applicant respectfully submits that one of ordinary skill in the art would **not** be motivated to modify the “plurality of different databases” disclosed by Montalbano to “perform a status check on terminals” since the “plurality of different databases” in Montalbano are not disclosed as having the capabilities necessary to allow them to be modified to “perform a status check on terminals.”

It is well-settled that a reference must provide some motivation or reason for one skilled in the art (working without the benefit of the applicants’ specification) to make the necessary changes in the disclosed device. The mere fact that a reference may be modified in the direction of the claimed invention does not make the modification obvious unless the reference expressly or impliedly teaches or suggests the desirability of the modification. In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984); Ex parte Clapp, 227 USPQ 972, 973 (Bd. App. 1985); Ex parte Chicago Rawhide Mfg. Co., 223 USPQ 351, 353 (Bd. App. 1984).

In re Bozek, 163 USPQ 545 does recite that one may use common sense, but this quote is in reference to determining if art is “non-analogous” and whether it can be combined with a second reference. However, the Bozek case recites, one section above the common sense section, that “we have said many times that a reference disclosure must be evaluated for all that it fairly suggests and not only for what is indicated as preferred” (emphasis in original). It is respectfully submitted that Montalbano does not suggest any device that is capable of being modified to “perform a status check on terminals” and by disclosing devices that perform functions only at the request of a user, teaches away from the modification asserted by the Examiner.

It is respectfully noted that the information server recited in the claims of the present invention transmits information to each terminal in an on-hook status after checking the on-hook status of the terminal or in other words, the information server must have the capability to transmit information to a terminal when a call is not in progress (“**on-hook**”) and to determine when a terminal is not involved in voice communication. On the other hand, it is further

respectfully noted that Montalbano discloses functions that are performed only when a telephone is “**off-hook**” and fails to disclose that the “plurality of different databases” have the capability to request information from or poll a communications device and, therefore, it is respectfully submitted that the “plurality of different databases” disclosed by Montalbano are not analogous to the information server recited by the claims of the present invention and are not capable of modification to “perform a status check on terminals.”

It is respectfully noted that Montalbano discloses an “interface database 60” and a “customer profile database 70” that are controlled by the “interface platform 50” when a “requesting party interfaces with the interface platform 50.” Col. 4, ll. 23-32. It is further respectfully noted that Montalbano discloses a “screen phone database 20” to which an interface is downloaded after a “user selects an interface package.” Col. 4, ll. 7-15. Moreover, it is respectfully noted that Montalbano discloses that the “user’s interface is changed ... each time the user takes the phone **off hook**.” Col. 4, ll. 49-56 (emphasis added).

It is respectfully submitted that Montalbano discloses devices that are capable of performing functions only when a communication device is “off hook” and only at the request of another party and, therefore, fails to disclose any devices that are capable of performing the functions required of the information server recited by the claims of the present invention. It is further respectfully submitted that the failure of Montalbano to disclose any devices capable of requesting information from or polling a communications device would preclude one of ordinary skill in the art from being motivated to modify the Montalbano invention to “perform a status check on terminals.”

In view of the aforementioned remarks, it is respectfully asserted that independent claims 1, 10 and 19 are allowable over the cited references. It is further respectfully asserted that claims 2 -9, which depend from claim 1, claims 11 -18, which depend from claim 10, and claims 20-22, which depend from claim 19, also are allowable over the cited references.

CONCLUSION

In view of the above remarks, Applicant submits that claims 1-22 of the present application are in condition for allowance. Reexamination and reconsideration of the application, as originally filed, are requested.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein; and no amendment made was for the purpose of narrowing the scope of any claim, unless Applicant has argued herein that such amendment was made to distinguish over a particular reference or combination of references.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California telephone number (213) 623-2221 to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,

LEE, HONG, DEGERMAN, KANG & SCHMADEKA

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By: 

Richard C. Salfelder
Registration No. 51,127
Attorney for Applicant

Customer No. 035884

Lee, Hong, Degerman, Kang & Schmadeka
801 S. Figueroa Street, 14th Floor
Los Angeles, California 90017
Telephone: 213-623-2221
Facsimile: 213-623-2211